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James D. Bledsoe

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EXAMINER

SARPONG, AKWASI

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/826,738	Applicant(s) BLEDSOE ET AL.	
	Examiner AKWASI M. SARPONG	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/16/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

1. Claims 1-15, 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo (2003/0058471) in view of Hirabayashi (7231369).

Claim 1, Okubo discloses a system (Section 0069, Fig. 2) comprising:

A processor (Section 0070, Fig. 2, El. 14 and 11); and

a memory (Section 0070, Fig. 2 El. 13) comprising firmware executable by the processor to cause the processor (Fig. 3 El 35) to:

operate a print mechanism in accordance with a first state associated with a capability of the print mechanism (Section 0071 where the first state is when it is in the copying mode as disclosed in Section 0099).

change the first state associated with the capability to a second state in response to receiving first information from an external interface (**PC 21 in Fig 2**); and (Section 0104, Fig. 8).

operate the print mechanism in accordance with the second state associated with the capability. (Section 0105, Fig. 8).

Okubo does not disclose transmitting first information associated with a selection to a server; receive second information from the server, where the second information is based on the first information;

Hirabayashi discloses a system where first information (**User name and password**) is transmitted and the first information is associated with a selection to a server (**membership database**) ; receive second information (**access or denial**) from the server, where the second information is based on the first information; (Col. 16 Lines 30-65). Therefore it will be obvious to one ordinary skilled in the art at the time the invention was made to modify Okubo's invention to include Hirabayashi's payment plan and members database so that user can be identified before access can be granted.

Claim 2, Okubo in view of Hirabayashi discloses a system wherein the first state comprises a disabled state, and wherein the second state comprises an enabled state.(Okubo: Section 0105, Fig. 8, where the user disable printer or copier mode to get into the mode and vice versa).

Claim 3, Okubo in view of Hirabayashi discloses a system wherein the first state comprises a first level of performance (**Printer mode**) (Section 0105), and wherein the

second state comprises a second level of performance (**Copier mode**) (Okubo: Section 0105).

Claim 4, Okubo in view of Hirabayashi discloses a system wherein the first information comprises an encryption key. (Col. 7 Lines 55-63).

Claim 5, Cancelled.

Claim 6, Cancelled.

Claim 7, Okubo in view of Hirabayashi discloses providing second information to a server using the external interface (Okubo: Section 0104, Fig. 8)

discloses wherein the firmware is executable by the processor to cause the processor to: detect a user input associated with the capability (Hirabayashi: Col. 8 Lines 29-35) and receive the first information associated with the capability of the print mechanism in response to providing the second information to the server (Hirabayashi: Col. 16 Lines 1-15).

Claim 8, Okubo (Section 0071, Fig. 2) in view of Hirabayashi (Col. 8 Lines 29-36) discloses a system wherein the firmware is executable by the processor to cause the processor to: provide the second information associated with the user input to the server by providing the second information to a computer system coupled to the external interface.

Claim 9, Okubo discloses a system (Section 0067, Fig. 1) comprising:
a print mechanism (**Print Controller**), (Okubo: Section 0069, Fig. 2 El. 10);
a print engine configured to operate the print mechanism (Okubo: Section 0069
Lines 11).

means for receiving a first selection of a first capability associated with the print
mechanism (Section 0071, Fig. 2 El. 12).

means for receiving first information associated with the first selection from a
server (Since image processing programs are stored in the server as disclosed in
section 0068, therefore the image commands are rendered from the server). and

means for changing a first indicator associated with the first capability from a first
state to a second state in response to receiving the first information (Section 0075, Fig.
3 El. 16).

Okubo does not disclose a means for transmitting the first selection to a server.

Hirabayashi discloses a means for transmitting (**Fig. 23, El. S744**) the first
selection to a server (Col. 16 Lines 30-40, thus the user's information is transmitted to
the server). Therefore it will be obvious to one ordinary skilled in the art at the time the
invention was made to modify Okubo's invention to include Hirabayashi's payment and
members information transmission means so that user can transmit their information to
the database server.

Claim 10, Okubo in view of Hirabayashi discloses a system further comprising:
a functional unit operable by the print engine (Section 0070, Fig. 2, El. 10);
means for receiving a second selection of a second capability associated with the
functional unit; (Section 0075, Fig. 2, El. 16).

means for receiving second information associated with the second selection
from the server (Since image processing programs are stored in the server as disclosed
in section 0068, therefore the image commands are rendered from the server); and
means for changing a second indicator associated with the second capability
from a third state to a fourth state in response to receiving the second
information (Section 0075, Fig. 3 El. 16 where the third and the fourth state will be
scanning and facsimile as disclosed in Section in 0067 lines 12-15).

Claim 11, Okubo in view of Hirabayashi discloses a system wherein the
functional unit is configured to perform a facsimile function, (**Okubo: Section 0067
Lines 11-14**).

Claim 12, Okubo in view of Hirabayashi discloses a system wherein the
functional unit is configured to perform a scanner function. (**Okubo: Section 0067,
Lines 13-15**).

Claim 13, Okubo in view of Hirahayashi discloses a system wherein the first capability comprises a performance capability (Okubo: It is inherent that print engine 23 has a print speed and resolution which is a performance capability).

Claim 14, Okubo in view of Hirahayashi discloses a system wherein the first capability comprises an upgrade capability (Section 0077, Fig. 2 El. 18).

Claim 15, Okubo in view of Hirahayashi discloses a system wherein the first capability comprises a functional capability. (Section 0067 Lines 11-14).

Claim 30, Okubo discloses a system wherein the firmware is further executable by the processor to cause the processor to:

operate a functional unit in accordance with a third state (**Scanning**) associated with a capability of the functional unit (Section 0067);

change the third state associated with the capability of the functional unit to a fourth state in response to receiving second information from the external interface; (Section 0067, Lines 10-14- where the second information is received from the function selecting unit, Fig. 2 El. 20) and

operate the functional unit in accordance with the fourth state (**Facsimile mode**) associated with the capability of the functional unit (Section 0109).

Claim 31, Okubo discloses a system wherein the functional unit is configured to perform a facsimile function (Section 0109).

Claim 32, Okubo discloses a system wherein the functional unit is configured to perform a scanner function (Section 0109).

Claim 33, Okubo discloses a system wherein the capability of the print mechanism comprises a print speed. (It is inherent that the print engine 23 in Fig. 2 comprises of a print speed).

Claim 34, Okubo discloses a system wherein the capability of the print mechanism comprises a print resolution. (It is inherent that the print engine 23 in Fig. 2 comprises of a print resolution).

Claim 35, Okubo discloses a system wherein the capability of the print mechanism comprises a software or hardware upgrade. (Section 0145).

Claim 17, Okubo discloses a method comprising:
receiving a selection of a capability associated with a print engine from a user (Fig.2 El. 20) enabling the capability in response to receiving information associated with the capability from a print controller (Section 0070).

Okubo does not disclose that the information is received from the server.

Hirabayashi discloses a system where information is received from the server (Col. 12 Lines 33-50). Therefore it will be obvious to one ordinary skilled in the art at the

time the invention was made to modify Okubo's method which get all it information from within the MFP with Hirabayashi's technology of transmitting the information from an external server so that user's of the system can be verified as disclosed by Hirabayashi in Col. 1 lines 45-60.

Claim 18, Okubo in view of Hirabayashi discloses a method where a receiving list of selectable capabilities from the server (Hirabayashi: Col. 12 lines 38-45) the list including the capability (Okubo: Section 0067).

Claim 19, Okubo (Section 0067, Fig. 2 El. 20) in view of Hirabayashi (Col. 19, Lines 63-67, Fig. 36) discloses a method of providing an interface for the user to select the capability from the list.

Claim 20, Okubo in view of Hirabayashi (Col. 15 Lines 37-55, Fig. 38) discloses a method, which provides an interface for the user to enter the payment information.

Claim 21, Okubo in view of Hirabayashi (Col. 15 Lines 37-55, Fig. 38) discloses a method, which provides the selection and the payment information to the server.

Claim 22, Okubo (Section 0070, Fig. 2 El. 20) in view of Hirabayashi (Col. 16 Lines 1-11) discloses a method, which comprises receiving information associated with the capability from the server in response to providing the selection and the payment information to the server.

Claim 23, Okubo (Section 0070, Fig. 2 El. 20) in view of Hirabayashi (Col. 16 Lines 49-66) discloses a method comprising receiving payment information associated with the selection from the user.

Claim 26, Okubo (Section 0077) in view of Hirabayashi (Col. 16 Lines 49-66) discloses a method wherein enabling the capability in response to receiving information associated with the capability from a server comprises upgrading software or hardware.

Claim 27, Okubo in view of Hirabayashi discloses a method receiving a selection of a capability associated with a functional unit from a user (Okubo: Section 0070, Fig. 2 El. 20); receiving from a server, information associated with the capability associated with the functional unit; and enabling the capability associated with the functional unit, in response to receiving from a server, information associated with the capability associated with the functional unit. (Hirabayashi: Col. 16 Lines 31-65).

Claim 28, Okubo (Section 0067, Lines 11-14) in view of Hirabayashi discloses a method wherein the capability associated with the functional unit comprises a facsimile capability.

Claim 29, Okubo (Section 0067, Lines 11-14) in view of Hirabayashi discloses a method wherein the capability associated with the functional unit comprises a scanner capability.

Claim Rejections - 35 USC § 103

2. Claims 24-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo (2003/0058471) in view of Hirabayashi (7231369) and in view of Yacoub (6552813).

Claim 24, Okubo in view of Hirabayashi discloses all the limitations in claim 17 as discussed above including enabling the capability in response to receiving information associated with the capability from a server.

Okubo in view of Hirabayashi does not disclose wherein the system comprises changing a print speed of the print engine.

Yacoub discloses a system comprises changing a print speed of the print engine. (Col. 6 Lines 50-55). Therefore it will be obvious to one ordinary skilled in the art at the time of the invention was made to modify the technology as taught by Okubo in view of Hirabayashi with the technology of Yacoub which comprises changing the print speed so that the user have the option of selecting the parameters of the print job as he desire as disclosed by Yacoub in Col. 6 Lines 50 –55.

Claim 25, Okubo in view of Hirabayashi discloses all the limitations in claim 17 as discussed above including enabling the capability in response to receiving information associated with the capability from a server.

Okubo in view of Hirabayashi does not disclose wherein the system comprises changing a print resolution of the print engine.

Yacoub discloses a system comprises changing a print resolution of the print engine. (Col. 7 Lines 55-65). Therefore it will be obvious to one ordinary skilled in the art at the time of the invention to modify the technology as taught by Okubo in view of Hirabayashi with the technology of Yacoub which comprises changing the print resolution so that the user have the option of selecting the parameters of the print job as he desire as disclosed by Yacoub in Col. 6 Lines 50 –55.

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okubo (2003/0058471) in view of Hirabayashi (7231369) and in further view Takeo (6950205).

Claim 16, Okubo in view of Hirabayashi discloses all the limitations in both claims 9 and 10. Okubo in view of Hirabayashi does not disclose a system wherein the first capability comprises a renewal capability.

Takeo discloses a system wherein a user license is renewed when the maximum value of the charge counter is reached. (Col. 4, Lines 11-30, Fig. 4 and 5). Therefore it will be obvious to one ordinary skilled in the art at the time of the invention to modify Okubo in view of Hirabayashi system with Takeo's renewal technology so that members

whose charge counter is at the maximum can reuse the service as taught by takeo in Col. 4 Line 25-39.

Response to Applicant's argument

New grounds of Rejection

1. Applicant's arguments filed 02/26/2008 have been fully considered but they are not persuasive.

With respect to Claim 1 and 9 Applicant argues that Okubo in View of Hirabayashi does not disclose transmission of information based on a selection (i.e., a customizable request) to a server. The server then transmits a response based on the selection that modifies a state of operation of a printer capability associated with the selection.

In reply Okubo in view of Hirabayashi discloses in Col. 14 lines 1-20. Thus the user login by entering his information and it is transmitted to the server and depending on the information from the user the server will either denial the user or grant access. Therefore Hirabayashi teaches the limitation as cited in claim 1.

With regards to Claim 17, applicant argues that Okubo in view of Hirabayashi does not disclose the limitation discussed earlier in claim 1 and 9.

In reply: examiner respectfully disagree because as explained earlier on Okubo in view of Hirabayashi teaches in Col. 14, Lines 1-20, that the user login by entering his information and it is transmitted to the server and depending on the information from

the user the server will either denial the user or grant access. Therefore Hirabayashi teaches the limitation as cited in claim 1.

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akwasi M. Sarpong whose telephone number 571-270-3438. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

AMS
05/08/2008